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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/880,417 | 06/13/2001 | Andrei V. Gudkov | 27611/37477 | 6487 |

4743 7590 02/12/2003

MARSHALL, GERSTEIN & BORUN
6300 SEARS TOWER
233 SOUTH WACKER
CHICAGO, IL 60606-6357

EXAMINER

GOLDBERG, JEROME D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1614

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,417

Applicant(s)

GUDKOV ET AL.

Examiner

Jerome D Goldberg

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-45 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 7, 10-12, 16, 22-32 and 35-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8, 9, 13-15, 17-21, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claims 3-5, 7, 10-12, 16, 22-32, and 35-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Applicants' remarks are ~~noted~~ and the elected invention is modified in that compounds wherein R_1 and R_2 together form an aliphatic or aromatic 5 to 8 – membered ring, X is S, and R_3 is alkylphenyl for preparing a host for a ^{bone} ~~line~~ narrow transplant. The other heterocyclic compounds wherein X is O or NH for treating all types of medical conditions such as cancer would support separate patents, clearly the other heterocyclic compounds would be search in different subclassed.

Therefore, the restriction requirement is deemed proper and made Final.

Claims 1, 6, 8, 9, 13-15, 17-21, 33 and 34 are being examined as they read on the elected invention as modified above.

Claims 6, 8, 9, 33 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "alkyl" in claims 8 and 9 fail to find basis in claim 6. Correction is required. The term "host" in claim 34 fails to find basis in claim 33. Correction is required.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1, 6, 8, 9, 13-15 and 17-21 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

The Mase et al. reference teaches applicants' compound, page 388, table 1, No. 9 has having no activity as an immunosuppressive agent. On page 386, col. 1, states on lines 1-4 of paragraph 1 that "immunosuppressive agents have been used for the treatment of some autoimmune diseases, such as systemic lupus erythematosus, rheumatoid arthritis and glomerulonephritis and in organ transplantation" the instant claims are directed to any disease condition therefore they read on the prior art conditions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Goldberg whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 3:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Jerome D. Goldberg", written in a cursive style.

Goldberg/LR
February 7, 2003

JEROME D. GOLDBERG
PRIMARY EXAMINER